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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,072

05/31/2006

Gerhard Hamprecht

3165-144

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6449

7590

12/29/2008

ROTHWELL, FIGG, ERNST & MANBECK, P.C.

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SUITE 800

WASHINGTON, DC 20005

EXAMINER

MURRAY, JEFFREY H

ART UNIT

PAPER NUMBER

1624

NOTIFICATION DATE

DELIVERY MODE

12/29/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/581,072	<b>Applicant(s)</b> HAMPRECHT ET AL.	
	<b>Examiner</b> JEFFREY H. MURRAY	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-15 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                                  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-15 and 17 are pending in this application. Claim 16 has been cancelled. This action is in response to the applicants' amendment after a non-final action and reply filed on September 26, 2008.

### ***Withdrawn Rejections/Objections***

2. Applicant is notified that any outstanding rejection/objection that is not expressly maintained in this office action has been withdrawn or rendered moot in view of applicant's amendments and/or remarks.

### ***Specification***

3. The disclosure is objected to because of the following informalities:

On page 11, last three lines of the specification, the application attempts to define the "A" term, as "...a group of the formula  $-N^5R^6$ ,..." Examiner believes this is a typographical error. No new matter is permitted. Appropriate correction is required.

### ***Claim Objections***

4. Claim 1 is objected to because of the following informalities:

Claim 1 reads, "A process for preparing a 3-phenyl(thio)uracil or 3-phenyldithiouracil of the formula I..." Examiner suggests altering the preamble to read, "A process for preparing a compound of the formula I..." as the structure of formula I already defines what is being prepared, not the text. Appropriate correction is required.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> Paragraph***

5. Claims 1-15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. The scope of the term “A” in claim 1 requires clarification. Applicants' examples in the specification are not limiting. Applicants have not defined these terms with reasonable clarity. See definitions on p.11 and 12 of the specification. Where applicants define terms with a special meaning, they must set out the special definition with "reasonable clarity, deliberateness and precision". Note *Teleflex v. Ficosa*, 63 USPQ2d 1374; *Rexnord Corp v. Laitram Corp.* 60 USPQ2d 1851 and MPEP 2111.01.

The terms are defined with non-limiting examples making them impossible to pin down. For example, when one states C<sub>1</sub>-C<sub>4</sub> alkyl, there are a small finite number of possibilities that exist in that set. One ordinarily skilled in the art realizes and understands this. However when one states, “...A radical which is derived from a primary or secondary amine...”, how can metes and bounds applicant intends be determined ? One skilled in the art could instantly envision several different “A radicals” that qualify under this broad, vague definition. Does the applicant wish to claim a primary amine, or an alkyl amine or something more like a carboxylic amide with heterocyclic groups? Applicant must narrow such broad terminology by either eliminating such a broad definition or by inserting the specific groups for R<sup>5</sup> and R<sup>6</sup> they wish to cover into the claim themselves. No new matter is permitted. Appropriate correction is required.

***Conclusion***

7. Claims 1-15 and 17 are rejected.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is 571-272-9023. The examiner can normally be reached on Mon.-Thurs. 7:30-6pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey H Murray/  
Patent Examiner  
Art Unit 1624

**/James O. Wilson/  
Supervisory Patent Examiner, Art Unit 1624**